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| 09/711,578 | 11/13/2000 | Nora Femenia | 2043.003USI | 7170 |

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EXAMINER

ELISCA, PIERRE E

ART UNIT PAPER NUMBER

3621

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/711,578
Filing Date: November 13, 2000
Appellant(s): FEMENIA ET AL.

John M. Dahl

A statement identifying by name the real party in interest is contained in
the brief.

For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 08/08/2006 appealing from the Office
action mailed 01/10/2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

| | | |
|-----------|--------------|--------|
| 6,553,347 | Tavor et al. | 4-2003 |
|-----------|--------------|--------|

| | | |
|-----------|--------------|--------|
| 6,556,974 | D'Alessandro | 4-2003 |
|-----------|--------------|--------|

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(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Allowable Subject Matter

1. Claims 9 and 19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-8, 10-18 and 20 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Tavor et al. (U.S. Pat. No. 6,553,347) in view of D'Alessandro (U.S. Pat. 6,556,974).

As per claims 1, 2, 5, 6, 10-12, 15 and 20 Tavor substantially discloses a method for conducting one to one commercial negotiations (**negotiating or managing a dispute between a user and a vendor**) through an electronic medium such as the Internet, comprising:

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automatically receiving information relating to the dispute from one of an initiator and a respondent, the initiator and the respondent being parties to the agreement (initiator and a respondent or user and vendor) see., abstract, col 4, lines 20-41, specifically wherein said that the negotiation process features one or more exchanges between the user and the system, including discounts given by the system and responses to the price offers of the user. The limitation "the initiator and the respondent being parties to the agreement" is also disclosed by Tavor in col 12, lines 13-28); and

iteratively providing portions of the information to the other of the initiator and the respondent in accordance with predetermined criteria relating to either a rating of a portion of the information supplied after a start of the dispute by the initiator or the respondent, or relating to the number of portions of the information to be provided at an iteration (see., abstract, col 4, lines 20-41, specifically wherein it is stated that the system offers the product for a specific price, a price that may be optionally decreased as negotiation continues, please note that the specific price is interpreted as the portion of the information.

Travor fails to explicitly disclose the step of "predetermining criteria". However, D'Alessandro discloses a method for evaluating current business performance. A predetermined set of performance criteria are measured by the use of an automated employee and non-employee interview system (see., abstract, col 3, lines 1-21).

As per the predetermined type of criteria being claimed, the Examiner submits that no patentable differences exist since a plurality types of predetermined

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criteria may exist. Thus, the type of predetermined criteria does not affect the functioning of the system of Tavor since data is data in computer manipulation. Incorporating such types of criteria in the system of Tavor would have been obvious to one of ordinary skill in the art at the time of the invention in order to evaluate and forecast of the business entity's performance.

As per claims 3, 13, and 16 Tavor discloses the claimed method wherein the received information includes at least one factor and an evaluation of the desirability or cost of the factor (see., 2, lines 56-61).

As per claims 4, and 14 Tavor discloses the claimed method wherein the at least one factor includes at least two of historical harm, future harm, an incentive, a punishment, a request, an offer, and a desired outcome (see., col 2, lines 31-41, lines 56-61).

As per claims 7, 8 and 17-18 Tavor discloses the claimed method of automatically proposing an agreement to resolve the dispute (or negotiation) based on the received information (see., col 12, lines 13-28).

(10) RESPONSE TO ARGUMENTS

Applicant's arguments filed on 10/19/2005 have been fully considered but they are not persuasive.

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In response to Applicant's arguments, Applicant argues that the prior art of record (Tavor and D'Alessandro) fail to disclose or suggest the recited feature:

a. "managing or resolving a dispute regarding a preexisting agreement".

Based upon the foregoing rejection detailed above, it is believed that Tavor discloses this assertion in the abstract, col 4, lines 20-41, specifically wherein said the negotiation process features one or more exchanges between the user and the system, including discounts given by the system and responses to the price offers of the user. The limitation "the initiator and the respondent being parties to the agreement" is also disclosed by Tavor in col 12, lines 13-28. Please note that response to the price of the user is interpreted as a step of resolving a price dispute.

b. "receiving information from parties to a dispute regarding a pre-existing agreement". As stated above, Tavor discloses this limitation in the abstract, col 4, lines 20-41, specifically wherein said the negotiation process features one or more exchanges between the user and the system, including discounts given by the system and responses to the price offers of the user. The limitation "the initiator and the respondent being parties to the agreement" is also disclosed by Tavor in col 12, lines 13-28.

c. "consider iteratively providing portions of information". However, the Examiner respectfully disagrees with this assertion since Tavor discloses this limitation in the abstract, col 4, lines 20-41, specifically wherein said system offers the product for a specific price, a price that may be optionally decreased as

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negotiation continues, please note that the specific price is interpreted as the portion of the information.

d. Applicant also argues that D'Alessandro fails to disclose " a predetermined criteria". However, D'Alessandro discloses a method for evaluating current business performance. A predetermined set of performance criteria are measured by the use of an automated employee and non-employee interview system (see., abstract, col 3, lines 1-21).

As per the predetermined type of criteria being claimed, the Examiner submits that no patentable differences exist since plurality of types of predetermined criteria may exist. Thus, the type of predetermined criteria does not affect the functioning of the system of Tavor since data is data in computer manipulation. Incorporating such types of criteria in the system of Tavor would have been obvious to one of ordinary skill in the art at the time of the invention in order to evaluate and forecast of the business entity's performance.

Appeal Conference

| No. | Claim 1 | Tavor US6,553,347 | D'Alessandro US 6,556,974 |
|-----|-------------------------------------------------------------------------------------|----------------------|------------------------------|
| 1 | managing a dispute as recited in claim 1 is readable as negotiating a dispute | ABSTRACT | |
| 2 | Receiving a dispute from one of | Abstract, col 4, | |

| | | | |
|---|-----------------------------------------------------------------------------------------------------------------------------------------------------------|-------------------------------------------------------------------------------------------------------------------------------------------|---------------------------------------------------|
| | an initiator and a respondent. An agreement between an initiator and respondent (an agreement between a user and a vendor) | lines 20-41. Please note that an initiator and respondent is readable as a user and a vendor. An agreement see col 12, lines 13-28 | |
| 3 | Portion of the information is interpreted as a specific price. A rating of a portion of the information is interpreted as a discount or incentive. | Col 4, lines 20-41 | Col 3, lines 1-21. Predetermined criteria. |

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Pierre Eddy Elisca

Primary Examiner

Conferees:

Andrew Fischer 

SPE, Art Unit 3621



Alexander Kalinowski

SPE, Art Unit 3627